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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/674,536	10/01/2003	Stephan Meyers	0171.37353CX1	5367

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EXAMINER

CHAMPAGNE, DONALD

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 03/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/674,536

Applicant(s)

MEYERS ET AL.

Examiner

Donald L. Champagne

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 October 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 1 Oct 2003.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities: The claims must commence on a separate sheet or electronic page (37 CFR 1.52(b)(3)). In reply to this Office action, applicant is required to submit a new copy of spec. p. 12 without claims printed thereon, and submit a new copy of the claims.

Double Patenting

2. The **nonstatutory double patenting** rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-12 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 21 of U.S. Patent No. US006674995B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because all the claims except 4, 8 and 12 are said claim 21 with limitations removed. It is always obvious to broaden an invention by removing claim limitations. Claims 4, 8 and 12 add the well-known limitation of product discounts (para. 13 below).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-12 are rejected under 35 U.S.C. 103(a) as being obvious over Luna (US005324028A) in view of Fennell, Jr., et al. (US005695400A).
6. Luna teaches (independent claims 1, 5 and 9) a method and mobile terminal for conducting a multi-player game in a wireless communications system, and a wireless telecommunications system, the method comprising: receiving, by a mobile terminal operated by a first player (*transceiver 19*, col. 11 lines 18-33), a message related to the multi-player game (*instructions received on the video monitor*, col. 2 lines 48-56), including information relating to rules for the multi-player game (col. 3 lines 40-43) and data automatically displayed on the display of the mobile terminal.
7. Note: Luna teaches a system for guiding players around a conventional golf course. Hence Luna teaches a game which is only partly conducted in a wireless communications system. The examiner could not find support in the specification for excluding games played only partly in a wireless communications system, so the Luna invention reads on the claims as indicated in para. 6 above.
8. Luna also teaches some arbitrary first player signaling completion of a hole, which initiates a cycle of groups moving between holes (col. 2 lines 56-59 and col. 3 lines 30-32), which reads on forwarding, by the mobile terminal/*transceiver 19* operated by the first player, a message to another mobile terminal.
9. Luna does not teach providing a promotional item to said mobile terminal operated by the first player if the message is forwarded within a period of time defined within the rules for the multi-player game. Fennell, Jr., et al. teaches providing a promotional item (col. 2 line 65) to said mobile terminal operated by the first player if the message is forwarded within a period

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of time defined within the rules for the multi-player game (col. 4 lines 63-65). Because Fennell, Jr., et al. teaches that this would mitigate delays (*network latency among terminals*, col. 1 lines 39-43), a problem also identified by Luna (col. 1 lines 10-12 and col. 2 lines 34-38), it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add the teachings of Fennell, Jr., et al. to those of Luna.

10. Neither reference teaches that the message includes a virtual ball. Because the subject game is golf and the object of a common message would be to indicate that the group sending the message is ready to tee off at a new hole, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add a virtual ball being teed off to the messages with the teachings of Luna and Fennell, Jr., et al.
11. Luna also teaches claims 2, 6 and 10 (col. 2 lines 12-15).
12. Neither reference teaches (claims 3, 7 and 11) that the advertising relates to the promotional item. Because the very mention of the promotional item would read on advertising said promotional item, and it would be obvious to mention any promotional item being offered, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add advertising of the promotional item to the teachings of Luna and Fennell, Jr., et al.
13. Neither reference teaches (claims 4, 8 and 12) that the promotional item comprises a discount on a product. Official notice is taken (MPEP § 2144.03) that discounts were a common form of promotion at the time of the instant invention. Because the game inherently has many products amenable to discounts (goods in the pro shop, greens fees), it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add to the teachings of Luna and Fennell, Jr., et al. that the promotional item comprises a discount on a product.

Suggestion of Allowable Subject Matter

14. The instant rejection over Luna in view of Fennell, Jr., et al. can be overcome by adding the limitation "wherein game points are scored by forwarding the virtual ball" to the end of each independent claim 1, 5 and 9. This limitation is supported by para. [0010] of the published application, US 20040102249A1.
15. Other amendments might overcome the instant rejection over the prior art. Applicant is invited to schedule an interview to discuss any other amendments of interest to applicant.

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16. Applicant is cautioned that the amendment suggested in para. 14 above would only overcome the prior art made of record. An allowance could be considered only after this or any other amendment were searched.

Conclusion

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L Champagne whose telephone number is 571-272-6717. The examiner can normally be reached from 6:30 AM to 5 PM ET, Monday to Thursday. The examiner can also be contacted by e-mail at donald.champagne@uspto.gov, and *informal* fax communications (i.e., communications not to be made of record) may be sent directly to the examiner at 571-273-6717.
18. The examiner's supervisor, Eric Stamber can be reached on 703-305-8469.¹ The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.
19. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).
20. **ABANDONMENT** – If examiner cannot by telephone verify applicant's intent to continue prosecution, the application is subject to abandonment six months after mailing of the last Office action. The agent, attorney or applicant point of contact is responsible for assuring that the Office has their telephone number. Agents and attorneys may verify their registration information including telephone number at the Office's web site, www.uspto.gov. At the top of the home page, click on Site Index. Then click on Agent & Attorney Roster in the alphabetic list, and search for your registration by your name or number.

DONALD L. CHAMPAGNE
PRIMARY EXAMINER

Donald L. Champagne
Primary Examiner
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17 March 2005

¹ 571-272-6724 after the middle of April 2005.